

REMARKS

Claims 26-49, 56-65 and 71-93 were pending prior to this amendment. Claims 26-49, 56-65, 71-75, 83 and 89 have been canceled without prejudice to pursue them in one or more continuation applications. Thus, claims 76-82, 84-88 and 90-93 are now pending.

Claim 82 has been amended to incorporate claim 83. Claim 88 has been amended to incorporate claim 89. Claims 84 and 90 have been amended to an independent claim format.

I. The rejection of claims 26-49, 56-65 and 71-93 under 35 U.S.C. § 112, first paragraph, written description

Claims 26-49, 56-65 and 71-93 have been rejected under 35 U.S.C. § 112, first paragraph, because the Examiner contends that a negative limitation (e.g., “a compound that is not a neurotransmitter precursor” and “is not milnacipran”) “does not provide one of ordinary skill in the art with any description of what the Applicant claims as the invention.”

The Applicant respectfully traverses this rejection. The rejection of claims 26-49, 56-65, 71-75, 83 and 89 is moot in view of the cancellation of these claims. Claims 82, 84-88 and 90-93 as amended no longer include a negative limitation. Claims 76-81 recite: “in combination with a compound that is not phenylalanine, tyrosine and/or tryptophan.” The MPEP states that “[t]he current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation.” See MPEP § 2173.05(i). A negative limitation or exclusionary proviso must have a basis in the original disclosure. *Id.* The limitation recited in claims 76-81 has such support. See, e.g., specification at page 10, line 28 to page 11, line 4. Accordingly, this rejection should be withdrawn.

II. The rejection of claims 26-49, 56-65 and 71-93 under 35 U.S.C. § 112, 2nd paragraph

Claims 26-49, 56-65 and 71-93 have been rejected under 35 U.S.C. § 112, 2nd paragraph. The Examiner contends that the claims (1) are indefinite because the compounds are defined by their functionality and (2) may read on compounds not yet known or understood. Further, according to the Examiner, “determining whether a given compound agonizes or antagonizes one or more

receptor sites involves much experimentation since a negative response in one patient does not necessarily mean the drug isn't useful, as no drug has 100% effectiveness. Thus, what success rate determines if a particular inhibitor is effective and how many patients (and dosage regimens) need to be tested?" (Office Action, page 6).

Applicants have canceled claims 26-49, 56-65, 71-75, 83 and 89. Accordingly, the rejection of these claims is moot. Claims 76-82, 84-88 and 90-93 are not indefinite because they recite milnacipran, a well-known compound. Thus, this rejection should be withdrawn.

III. The rejection of claims 27-34, 36-42, 44-49, 57-60 and 71-75 under 35 U.S.C. § 112, 2nd paragraph

Claims 27-34, 36-42, 44-49, 57-60 and 71-75 under 35 U.S.C. § 112, 2nd paragraph because the Examiner contends that there is insufficient antecedent basis for "a compound of formula 1" (Office Action, page 6). These claims have been canceled. Accordingly, this rejection should be withdrawn.

IV. The 35 U.S.C. § 102 rejections

The Examiner has withdrawn the 35 U.S.C. § 102 rejections of claims 28, 58 and 63.

A. The rejection of claims 26, 29, 32, 33, 35, 39-41, 43, 47, 48, 56, 60, 61, 65, 66, 70, 71, 73, and 75 under 35 U.S.C. § 102(b)

The Examiner has maintained the rejection of claims 26, 29, 32, 33, 35, 39-41, 43, 47, 48, 56, 60, 61, 65, 66, 70, 71, 73, and 75 under 35 U.S.C. § 102(b) as anticipated by WO 00/32178 ("178"). This rejection is moot in view of the cancellation of these claims.

B. The rejection of claims 26 and 61 under 35 U.S.C. § 102(b)

The Examiner has maintained the rejection of claims 26 and 61 as anticipated by Ninan, Depression Anxiety 2000;12(Suppl 1):90-94 (abstract) ("Ninan"). Claims 26 and 61 have been canceled. Accordingly, this rejection should be withdrawn.

C. The first rejection of claim 61 under 35 U.S.C. § 102(b)

The Examiner has maintained the rejection of claim 61 as anticipated by MEDLINE AN 2001337451, Barkin et al., Am J Therapeutics 2000;7(1):31-47 (abstract) (“Barkin”). This rejection is moot in view of the cancellation of claim 61.

D. The second rejection of claim 61 under 35 U.S.C. § 102(b)

Claim 61 has been rejected as anticipated by MEDLINE AN 97363915, Aronson, Clin Therapeutics 1997;19(3):420-432 (abstract) (“Aronson”) and MEDLINE AN 97229930, Lewis et al., Am J Health System Pharmacy 1997;54(6):643-652 (abstract) (“Lewis”). Claim 61 has been canceled. Accordingly, this rejection should be withdrawn.

E. The rejection of claim 61 under 35 U.S.C. § 102(a)

Claim 61 has been rejected as anticipated by MEDLINE AN 2001240387, Enggaard et al., Clin Pharmacol Therapeutics 2001;69(4):245-251 (abstract) (“Enggaard”). This rejection should be withdrawn in view of the cancellation of claim 61.

VI. The rejection of claims 26, 28-35, 37-43, 45-50, 56, 58-61, 63-66, 68-71, and 73-75 under 35 U.S.C. § 103(a)

Claims 26, 28-35, 37-43, 45-50, 56, 58-61, 63-66, 68-71, and 73-75 have been rejected as obvious over Ninan in view of ‘178. These claims have been canceled. Accordingly, this rejection should be withdrawn.

Conclusion

No new matter has been added by these amendments. In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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